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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
PRATT, HELEN F	

ART UNIT	PAPER NUMBER
1761	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/814,219	COBURN, KATALIN	
	Examiner	Art Unit	
	Helen F. Pratt	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 June 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 11-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9, 11-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is indefinite in the use of the phrase "very low oil separation". It is not known how much oil is required. For instance, how much oil is on top of the peanut butter after it sits. No new matter can be added to the claims or specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 10-28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for particular amounts, does not reasonably provide enablement for broadening amounts by using the term "about". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. Wherever amounts are seen, the terms are in definite amounts, and not in amounts, which say "about". See page 5, line 8, and page 10, line 8.

Also, no basis is seen as in claims 24 and 27 for the phrase "wherein the spices...comprise an amount sufficient to produce very low oil separation..." Nothing is

seen in the specification to show that there is a relationship between the amount of spices and/or flavorings which affects oil separation.

No basis is seen as in claim 5 of "blending spices... with the nut paste during grinding. This is different than blending ingredients with a nut paste. See pages 9-11, particularly, page 10, lines 13-17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 11-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edson (306,727) in view of the prior art (specification page 7, lines 15-22) and Cammarn et al. (5,417,999) and Avera (3,615,590) and Stockton (1,395,934).

Edson discloses a process of making a peanut paste by roasting peanuts and grinding the peanuts (col. 1, lines 10-40). No mention is seen of blanching the nuts. Claim 1 differs from the reference in the use of unblanched peanuts (for the sake of argument) and in roasting nuts to a particular temperature and in the step of grinding to a coarse paste with a particular particle size. Applicant's specification on page 7, lines 15-21) discloses that it is known to make natural peanut butters without adding hydrogenated fats or emulsifiers. Cammarn et al. disclose that it is known to make peanut butter using unblanched white skinned peanuts (abstract) and to roast the nuts to 420 F for 4.4 minutes (col. 4, lines 60-70). Avera discloses that roasting develops

flavors (col. 4, lines 30-50). As roasting of nuts is well known, and it is known that roasting develops flavors, it is seen that it would have been within the skill of the ordinary worker to roast at a particular temperature, since the flavor developed during roasting is due to a time- temperature relationship. Stockton discloses that the degree of oil separation can be prevented partially by coarse grinding, that the finer the grinding the more pronounced the tendency to gravitational separation (page 1, lines 89-103). Therefore, it would have been obvious to one of ordinary skill in the art to use unblanched peanuts as disclosed by Cammarn et al and to roast to a particular temperature to develop the flavor of the nuts, and to grind to a coarse grind as shown by Stockton in the process of Edson.

The independent claims further require that the composition has a low fat content and a low oil separation, and does not rely on hydrogenated oils, stabilizers, emulsification processes and has a very low oil separation. Edson discloses applicant's process and does not require any of the ingredients or processes, which are not, required as in claims 1 and 19 and has a low oil separation, as the process has been shown in combination. As above, if it is known that a particular degree of grinding keeps the nuts from exuding oil, then it would have been obvious to grind to the degree in which the level of oil exudation is acceptable. Therefore, it would have been obvious to treat as claimed as shown by the above references.

Claim 2 further requires a particular dark color. However, as above it is known to roast to develop flavors, and it would have been within the skill of the ordinary worker to

roast to a particular color. Therefore, it would have been obvious to roast to particular colors.

Claims 3 and 4 further require particular sizes of nut particles. However, as above, it is known that oil separation can be partially prevented by coarse grinding; it would have been obvious to grind to particular degrees, which also allow for a minimum of oil exudation. Therefore, it would have been obvious to grind to levels, which still kept the oil from exuding since such is the aim of the coarse grinding.

Certainly a temperature of from 145 to 165 as in step 6 can be reached in any normal cooling step. It is not clear from the reference to Edson just what temperature is generated during the grinding step. Nothing is seen that it would not have been as claimed. Therefore, it would have been obvious to cool to temperatures below the grinding temperature.

Claim 7 further requires putting the peanut paste into an agitating, mixing bank. However, no weight is given to the type of apparatus in a process claim. Certainly, agitators such as mixers are well known. The reference discloses adding ingredients such as to the mixture (col. 2, lines 40-48). Therefore, it would have been obvious to add sugar or salt to the peanut mixture and agitate by known mechanical means.

Claim 8 further requires adding dried fruits into the peanut mixture. Edson discloses using peanut paste with sweetmeats, which are known to be candied fruits. Therefore, it would have been obvious to add fruit to the peanut paste and to use dried fruits for convenience.

Nothing new is seen in adding extracts to the peanut mixture as in claim 23, and 26. Attention is invited to In re Levin, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Therefore, it would have been obvious to add additional ingredients to the composition.

Additional limitations such as mixing and blending for a particular length of time as in claim 11, using particular low temperatures as in claim 12 and pumping the mixture are seen as obvious given the technology of the times.

The limitations of claims 14 –18 have been disclosed above and are obvious for those reasons.

Claims 19 and 20 further require roasting the nuts at particular temperatures of about 350 F. However, as above no basis is seen for the phrase "about". Avera

discloses that it is known to roast peanuts to a temperature of 350 F. (col. 4, lines 35-36). The reference discloses that the development of roast flavor is a time-temperature phenomenon. Therefore, it would have been obvious to roast to the claimed degree as shown by Avera in the process of the combined references.

Edson discloses the use of peanuts as in claims 21 and 22.

Edson discloses adding flavorings such as sugar as in claims 23 and 26(col. 2, lines 40-44). Avera discloses adding flavorings at within the claimed amounts. (col. 6, lines 28-30).

Claims 24, 27, 28 further require particular amounts of spices or flavorings. However, Edson discloses the addition of sugar, which is a flavorant (col. 2, lines 40-44). Nothing is seen that the amounts of one part of peanut past to seven parts of sugar would affect the amount of oil separation. In addition, the amounts are seen as within the skill of the ordinary worker as in claims 24, 27 and 25. Therefore, it would have been obvious to add particular amounts of spices or flavorings to the claimed composition.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to the above claims, and further in view of Bolton (1,687,154).

Claim 5 further requires that other ingredients be added to the peanut paste. This is so well known, that a reference is hardly required. Honey and jelly are well known ingredients, which are added to peanut paste as are sugar and salt. Also, Bolton discloses that it is known to add cucumbers to peanut butter (col. 1, lines 12-50).

Therefore, it would have been obvious to add known ingredients to the peanut paste in the process of the combined references.

Claim 5 now requires that the ingredients are added during the grinding step. However, no basis is seen for this limitation as above. In addition, Stockton discloses that it is known to add salt in the grinding step (page 2, lines 62-65, col. 2, lines 1-75). Therefore, it would have been obvious to add flavoring ingredients in the grinding step in the process of the combined references.

ARGUMENTS

Applicant's arguments filed 6-11-07 have been fully considered but they are not persuasive. Applicant argues that the reference to Stockton relies on the use of hydrogenated oils to prevent oil separation. However, the reference to Stockton was used in combination to show that it was known to use coarse particles to prevent oil separation. That the finer the grind the more oil separation occurs. The fact that the separation of oil is only a partial degree is not seen as a persuasive argument since applicant does not claim a particular degree of oil separation, but claims "very low", and it is not known what is meant by this phrase. In addition, since it is known that coarse grinding prevents the separation of oil to some degree, it is seen that it would have been within the skill of the ordinary worker to grind to a degree, which is acceptable to the applicant as to oil separation. Even if Stockton teaches away from coarse grinding in his invention, the reference does show that it was known that coarse grinding produces less oil separation.

Applicant argues that Avera teaches away from applicant's invention by using blanched nuts. However, Avera was used to show that it is known that roasting develops flavors, and is therefore, within the skill of the ordinary worker to roast to a particular degree.

As to Cammarn, the reference discloses that it is known to make peanut butter using unblanched white skinned peanuts (abstract) and to roast to 420 F for 4.4 minutes (col. 4, lines 60-70). The reference discloses that the use of peanut skins is lower in calories as applicant has discussed (col. 2, lines 17-30). Applicant is basically making a peanut paste as disclosed in col. 2, lines 30-50.

Applicant argues that Cammarn discloses that the use of no stabilizers and emulsifiers results in gravitational instability, or oil separation. However, Applicant uses a known method, of grinding peanuts or nuts to large particles, which is known as above and accepts that there is some oil separation. Nothing is seen that applicant does not have some oil separation.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that entirely different processing techniques make it impossible to combine the references. Specifically that Edson's product is a candy. However, Nothing is seen that applicant's nut product could not be combined with sugar. The references specifically disclose most of applicant's process. The claims are not to a product, but to a process. The references are used for what they teach as above. Often, the reference is used for what was disclosed in the prior art. If these various teachings are known, and applicant is supposed to be aware of the prior art, then nothing keeps applicant from using known teachings from the prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hp 7-1-07

H. Pratt

HELEN PRATT
PRIMARY EXAMINER